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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/531,747

04/18/2005

Peggy E. Hellberg

2395 US F

3474

7590

04/29/2009

Alcon Research  
6201 South Freeway  
Fort Worth, TX 76134

EXAMINER

HUANG, GIGI GEORGIANA

ART UNIT

PAPER NUMBER

1612

MAIL DATE

DELIVERY MODE

04/29/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/531,747	<b>Applicant(s)</b> HELLBERG, PEGGY E.	
	<b>Examiner</b> GIGI HUANG	<b>Art Unit</b> 1612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of Application***

1. The response filed March 10, 2009 has been received, entered and carefully considered. The response affects the instant application accordingly:
  - a. Claim 1 has been amended.
2. Claim 1 is pending in the case.
3. Claim 1 is present for examination.
4. The text of those sections of title 35.U.S. Code not included in this action can be found in the prior Office action.
5. All grounds not addressed in the action are withdrawn or moot.
6. New grounds of rejection are set forth in the current office action.

### ***New Grounds of Rejection***

7. Due to the amendment of the claims the new grounds of rejection are applied:

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Xiao (U.S. Pat. 7250514) in view of Clark et al. (U.S. Pat. 5464866).

Xiao teaches the use of particular histone deacetylase inhibitors including suberoylanilidine hydroxamic acid, to treat conditions with abnormal angiogenesis and

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neovascularization including diabetic retinopathy and neovascular glaucoma (Abstract, Col. 3 line 1-Col. 4 line 36, Col. 14, line 8-Col. 15 line 13, Col. 29 lines 49-65, Col. 30 line 19).

Xiao does not expressly teach the use of the histone deacetylase for primary open glaucoma (chronic glaucoma).

Clark et al. teaches that affecting neovascularization can treat ocular neovascular conditions including diabetic retinopathy, neovascular glaucoma, and chronic glaucoma (Col. 7 line 34-63).

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to utilize the histone deacetylase inhibitors such as suberoylanilidine hydroxamic acid for chronic glaucoma, as suggested by Clark et al., and produce the instant invention. It would have been obvious to one of skill in the art as Xiao teaches that the compounds (e.g. SAHA) treat abnormal angiogenesis and neovascularization such as diabetic retinopathy and neovascular glaucoma; Clark teaches that treatment of neovascular conditions of the eye includes diabetic retinopathy, chronic glaucoma, and neovascular glaucoma; and it would be obvious to one of skill in the art use the histone deacetylase inhibitors which treats neovascular conditions and names diabetic retinopathy and neovascular glaucoma, to treat other related neovascular conditions of the eye such as chronic glaucoma as addressed by the art.

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One of ordinary skill in the art would have been motivated to do this because it is desirable to treat as many neovascular conditions as possible and it is desirable to be able to treat as many patient populations as possible with the same compound.

### ***Double Patenting***

10. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3 of copending Application No. 10/697135. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compounds of the instant claim anticipate the copending claims as the same compounds are present and claimed in the copending application for treatment of the same claimed condition primary open angle glaucoma (chronic glaucoma) which is also claimed in the copending application with other ocular neovascular conditions.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

11. Claim 1 is rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GIGI HUANG whose telephone number is (571)272-9073. The examiner can normally be reached on Monday-Thursday 8:30AM-6:00PM EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fredrick Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GH  
/Zohreh A Fay/  
Primary Examiner, Art Unit 1612